

ESTTA Tracking number: **ESTTA561614**Filing date: **09/26/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Chrysler Group LLC		
Entity	limited liability company	Citizenship	Delaware
Address	1000 Chrysler Drive Auburn Hills, MI 48236 UNITED STATES		

Attorney information	Judith A. Powell KILPATRICK TOWNSEND & STOCKTON LLP 1100 Peachtree Street, Suite 2800 Atlanta, GA 30309 UNITED STATES tadmin@kilpatricktownsend.com, jpowell@ktslaw.com, jdeal@ktslaw.com, lcrumley@ktslaw.com, brook@ktslaw.com Phone:404-815-6500
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Registration Subject to Cancellation

Registration No	3912705	Registration date	02/01/2011
Registrant	MOAB INDUSTRIES, LLC 661 N. BEARCLAW PRESCOTT, AZ 86301 UNITED STATES		

Goods/Services Subject to Cancellation

Class 037. First Use: 2005/03/04 First Use In Commerce: 2005/03/04
All goods and services in the class are cancelled, namely: Automotive conversion services, namely, installing specialty automotive equipment

Grounds for Cancellation

The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85650654	Application Date	06/13/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MOAB		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 012. First use: Motor vehicles, namely, passenger automobiles, their structural parts, trim and badges

Attachments	TM - MOAB INDUSTRIES - Petition to Cancel.pdf(196039 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Judith A. Powell/
Name	Judith A. Powell
Date	09/26/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHRYSLER GROUP LLC,

Petitioner,

v.

MOAB INDUSTRIES, LLC,

Respondent.

Cancellation No. _____

Registration No. 3,912,705
(TM: MOAB INDUSTRIES)

PETITION TO CANCEL

Petitioner Chrysler Group LLC (“Chrysler” or “Petitioner”), a Delaware limited liability company, with a principal place of business at 1000 Chrysler Drive in Auburn Hills, Michigan, 48236, is being and will continue to be damaged by U.S. Trademark Registration No. 3,912,705 for the mark MOAB INDUSTRIES, owned by Moab Industries, LLC (“Respondent”). Accordingly, pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064, Chrysler petitions to cancel Registration No. 3,912,705.

Chrysler alleges the following grounds for its petition:

Chrysler and Its Marks

1. Chrysler is one of the nation’s leading manufacturers of automotive vehicles and producer of the famous Chrysler®, Dodge®, Jeep®, Wrangler®, and Ram® brand cars and trucks. Respondent is causing damage to Chrysler and to its Jeep®, Wrangler®, and Ram® brands in particular through the misuse of Respondent’s registered mark—Respondent intentionally identifies goods and services that it provides under its mark with Chrysler’s famous Jeep®, Wrangler®, and Ram® brands and has misrepresented that its MOAB INDUSTRIES brand services include building Jeep®, Wrangler®, and Ram® brand vehicles.

Through registration and use of its mark, Respondent is, therefore, deceiving the public, tarnishing Chrysler's brands, and preventing Chrysler from registering the MOAB mark long associated with its Jeep® brand. Accordingly, Chrysler is petitioning to cancel Respondent's registration in order to stop Respondent from wrongfully using the registered mark to cause further harm.

2. For more than 60 years, Chrysler and its predecessors in interest have manufactured and sold the Jeep® brand vehicle to consumers. As the original sport utility vehicle, first sold to the U.S. military for use during World War II, the Jeep® vehicle and brand have long been well-known to the public. Today, Chrysler sells a full line of Jeep® sport utility vehicles, consisting of five primary models: Wrangler®, Cherokee®, Grand Cherokee®, Patriot®, and Compass®.

3. Over the years, Chrysler has obtained numerous federal trademark registrations for its Jeep® brand, including the following incontestable registrations: U.S. Registration Nos. 526,175; 1,081,322; 1,129,553; 1,130,015; 1,128,972; 1,129,828; 1,134,153; 1,236,540; 2,461,861; 2,512,866; 2,586,284; 2,635,685; 2,681,201; 2,729,404; 2,800,213; and 2,849,309.

4. In addition, Chrysler owns incontestable federal trademark registrations for its Wrangler® brand, including U.S. Registration Nos. 2,602,935 and 1,557,843.

5. Chrysler also owns numerous incontestable registrations for the iconic seven-slot grille design incorporated in its Jeep® brand vehicles, including the following: U.S. Registration Nos. 2,924,936; 2,823,099; 2,732,021; 2,161,779; 2,794,553; and 2,764,249 (collectively, the "Jeep® Grille Design Mark").

6. Moreover, the Jeep® Wrangler® model bears a distinctive trade dress that combines the seven-slot grille, flat front nose, round head lamps, trapezoidal wheel well openings, removable top and doors, and flat back (collectively, the “Jeep® Wrangler® Trade Dress”). It is intended to, and does, create the same commercial impression as the original Jeep® model and the long line of models in the Jeep® brand vehicle family. Due to its longstanding exclusive use, the Jeep® Wrangler® Trade Dress is recognized throughout the United States as exclusively associated with the Jeep® brand.

7. For more than for 35 years, Chrysler and its predecessors in interest have manufactured and sold the Ram® model vehicle to consumers. Today, Chrysler sells a full line of Ram® brand vehicles, including its extremely popular Ram® 1500 model truck.

8. Over the years, Chrysler has obtained numerous federal trademark registrations for its Ram® brand, including the following incontestable registrations: U.S. Registration Nos. 1,169,189; 2,902,398; 3,236,959; 3,236,961; 3,599,223; and 3,806,969.

9. Additionally, Chrysler owns multiple trademark registrations for the well-known Ram® Cross-Hair Grille Design Mark®, including the following: U.S. Registration Nos. 3,160,030 and 3,341,561.

10. For more than for 95 years, Chrysler and its predecessors in interest have also manufactured and sold the Dodge® brand vehicle to consumers, and Chrysler also owns numerous federal trademark registrations for its Dodge® brand, including the following incontestable registrations: U.S. Registration Nos. 364,669; 569,431; 1,189,233; 1,409,844; 3,032,735; and 3,262,239.

11. Chrysler and its predecessors have sold tens of millions of Jeep® and Ram® brand vehicles. Chrysler and its predecessors, together with the Jeep® and Ram® dealer associations, have also spent over a billion dollars on advertising and other promotional materials in connection with the Jeep® and Ram® brands, promoting Jeep® and Ram® products in a wide range of media, including television, radio, print and online.

12. Chrysler routinely receives awards within the motor vehicle industry in honor of the consistent high quality and performance of its Jeep® brand vehicles. For example, the Jeep® Grand Cherokee® model is the most awarded SUV ever, and the Jeep® Wrangler® model in particular has repeatedly received awards and recognition for off-roading capabilities. In recent months alone, *Four Wheeler* magazine named the Jeep® Wrangler® Rubicon® “Four Wheeler of the Year” and named the Jeep® Wrangler® Rubicon® and Wrangler® Unlimited Rubicon® the “Best 4X4 Vehicles of the Decade,” and Autobytel named the Wrangler® its 2012 SUV of the year. The 2012 Jeep® Wrangler® also won the Special Equipment Market Association (SEMA) Hottest SUV Award, which honors those vehicles that specialty-equipment manufacturers believe showcase the latest and most innovative products and provide the best platforms for accessorizing. And *Petersen's 4-Wheel & Off-Road* magazine named the Jeep® Wrangler® Moab™ model the 2013 “4x4 of the Year.”

13. Chrysler also routinely receives awards within the motor vehicle industry in honor of the high quality and performance of its Ram® brand vehicles. This year alone, the Ram® 1500 model truck was named *Motor Trend's* 2013 Truck of the Year, the 2013 Rocky Mountain Truck of the Year by the Rocky Mountain Automotive Press, the 2013 North

American Truck/Utility of the Year, and the Truck of Texas 2013 by the Texas Auto Writers Association.

14. As a result of the longstanding use and widespread promotion of the Jeep® brand, the Wrangler® brand, the Ram® brand, the Jeep® Grille Design Mark®, the Ram® Cross-Hair Grille Design Mark®, and the Jeep® Wrangler® Trade Dress (collectively, the “Marks”), the substantial sales made in connection with the Marks, and the high quality of products offered under them, the Marks have garnered tremendous goodwill over the years and become famous among the consuming public throughout the country, who readily associate them with Chrysler.

15. Jeep® brand vehicles have also long been associated by the public and the press with the well-known challenging, rugged off-roading trails in and around Moab, Utah, with Chrysler and its predecessors having participated in and sponsored multiple Jeep® brand enthusiast events and press events there for decades. At the Moab Easter Jeep Safari off-roading event, a nine-day annual event, started in 1967 and attended by hundreds of enthusiasts each year, Chrysler has, for years, conducted workshops, demonstrated Jeep® brand concept vehicles, showcased specially equipped Jeep® brand vehicles, and unveiled new Jeep® brand models. And since 1998, Chrysler’s licensee has conducted the annual MOAB Jeep® Jamboree event, a three-day rock-crawling off-roading event that has attracted thousands of Jeep® brand enthusiasts over the years.

16. The long and extensive association and identity of the Jeep® brand with the off-roading trails and events in and around Moab, Utah inevitably led to Chrysler’s use of the MOAB mark in connection with its Jeep® brand. For example, in addition to the licensed

MOAB Jeep® Jamboree, since 2003, Chrysler has sold a MOAB brand vehicle wheel for its Jeep® Wrangler® Rubicon® model, and in 2012, it decided to extend use of MOAB to a Jeep® Wrangler® vehicle model name.

17. Thus, on June 13, 2012, Chrysler filed an intent-to-use based application, U.S. Application Serial No. 85/650,654, with the United States Patent and Trademark Office (the “USPTO”) for the trademark MOAB for use in connection with “[m]otor vehicles, namely, passenger automobiles, their structural parts, trim and badges.”

18. Since that time, Chrysler has used the MOAB mark as an edition designation for its famous Jeep® Wrangler® model, offering a Jeep® Wrangler® Moab™ edition and a Jeep® Wrangler® Unlimited Moab™ edition.

Respondent’s Trademark Application and Misrepresentation of the Source of Its Goods

19. Respondent is a corporation organized under the laws of the State of Arizona, with a mailing address at 661 N. Bearclaw, Prescott, Arizona 86301.

20. On information and belief, Respondent is in the business of installing specialty, aftermarket off-roading automotive equipment, primarily on Jeep® and Ram® brand vehicles, and offering automotive conversion services. Respondent operates its business in Arizona and has no location or business operations in or around Moab, Utah.

21. On October 9, 2008, Respondent filed a use-based application with the USPTO, Application Serial No. 77/589,936, to register the mark MOAB INDUSTRIES.

22. On February 1, 2011, Respondent obtained Registration No. 3,912,705 for the mark MOAB INDUSTRIES for use in connection with “Automotive conversion services, namely, installing specialty automotive equipment.”

23. Respondent intentionally selected and adopted the MOAB INDUSTRIES mark for the very purpose of trading on the Jeep® brand's connection with Moab off-roading. And, Respondent has built its business by deliberately making prominent and repeated use of the Jeep®, Wrangler®, and Ram® brands, the Jeep® Grille Design Mark®, the Ram® Cross-Hair Grille Design Mark®, and the Jeep® Wrangler® Trade Dress in its marketing in order to trade on the Jeep® brand and its longstanding connection with the MOAB name. For example, Respondent's website <www.moabindustries.com> and other marketing is replete with, and dominated by, pictures and videos of, and references to, Chrysler's Jeep®, Wrangler®, and Ram® brand vehicles. The website prominently and repeatedly displays Chrysler's JEEP, WRANGLER, and RUBICON marks, as well as the iconic Jeep® Grille Design Mark® and Jeep® Wrangler® Trade Dress. Respondent further misleads consumers that it is the source of Chrysler's products by also featuring in its marketing Chrysler's DODGE and RAM marks, Ram® brand trucks, and Chrysler's famous Ram® Cross-Hair Grille Design Mark®.

24. Indeed, on its website promoting MOAB INDUSTRIES brand services, Respondent made numerous affirmative misrepresentations respecting Jeep® and Wrangler® brand vehicles, as well as Chrysler's Dodge® and Ram® brand vehicles. The statements have misrepresented the source of MOAB INDUSTRIES brand goods and services, and the statements have been intended to, and have, traded on Chrysler's goodwill and the goodwill of its famous brands. For example, Respondent made numerous misrepresentations in its marketing to the effect that it "builds" or "produces" Jeep® Wrangler® and Dodge® brand vehicles, including the following:

“[o]ur first and primary product that we produce is the Jeep Wrangler, of which we mostly build the Unlimited.”;
“Our secondary build is the Dodge 2500 Cummins Turbo Diesel”;
“We also build custom rock crawling [W]ranglers”; and
“[W]e build the highest quality branded Jeep on the market”

Harm to Chrysler

25. On September 3, 2012 and April 2, 2013, the examining attorney issued office actions refusing to register Chrysler’s MOAB mark, Application Serial No. 85/650,654, citing the mark covered by Registration No. 3,912,705 owned by Respondent.

26. Further, based on U.S. Registration No. 3,912,705 and claimed use of the MOAB INDUSTRIES mark, Respondent filed a lawsuit against Chrysler on December 7, 2012, in the United States District Court for the District of Arizona, Civil Action No. 3:12-cv-08247-HRH, to prevent Chrysler from using its MOAB mark.

27. Chrysler is suffering ongoing damage as a result of Registration No. 3,912,705:
a) it is being denied registration of its mark, b) Respondent is misusing the mark covered by the registration to misrepresent the source of Respondent’s goods and services and identify them with Chrysler’s Jeep®, Wrangler®, and Ram® brands and their well-known longstanding association with the MOAB name, c) Respondent is tarnishing Chrysler’s Jeep®, Wrangler®, and Ram® brands by identifying its goods and services with them, and d) Respondent is leveraging its misuse of the mark to try to prevent Chrysler from using the very name with which it has long been associated.

FIRST GROUND FOR CANCELLATION
Misrepresentation of the Source of Goods

28. Chrysler repeats and incorporates by reference the allegations in the preceding paragraphs in this Petition.

29. U.S. Trademark Registration No. 3,912,705 for the mark MOAB INDUSTRIES for use in connection with “[a]utomotive conversion services, namely, installing specialty automotive equipment” is invalid because it is being used by Respondent to misrepresent the source of the goods or services on or in connection with which the mark is used.

30. Chrysler has been and continues to be injured by the existence of U.S. Registration No. 3,912,705.

31. Accordingly, pursuant to 15 U.S.C. § 1064(3), the Board should cancel Registration No. 3,912,705 in its entirety.

SECOND GROUND FOR CANCELLATION
Likelihood of Confusion

32. Chrysler repeats and incorporates by reference the allegations in the preceding paragraphs in this Petition.

33. The Examiner has determined there is a likelihood of confusion of Chrysler’s MOAB mark with Respondent’s MOAB INDUSTRIES mark that is the subject of Registration No. 3,912,705. Respondent has also affirmatively asserted in the federal court litigation there is likely confusion between Chrysler’s MOAB mark when used in connection with its products and Respondent’s MOAB INDUSTRIES mark when used in connection with its services.

34. Ordinarily there would be no likelihood of confusion between Chrysler’s MOAB mark when used in connection with its products and Respondent’s MOAB INDUSTRIES mark

when used in connection with its services. To the extent there is any likely confusion, it is being caused by Respondent's excessive and prominent use of Petitioner's famous Jeep®, Wrangler®, Ram®, Jeep® Grille Design, and Ram® Cross-Hair Grille Design marks in conjunction and juxtaposition with Respondent's marks and Respondent's intentional adoption of a mark that was already associated with Chrysler and its Jeep® brand before Respondent's adoption.

35. To the extent there is likelihood of confusion, then Respondent's MOAB INDUSTRIES mark, when used in connection with Respondent's services of installing specialty aftermarket automotive equipment (which includes installation of automotive wheels and/or equipment related to wheels), so resembles Petitioner's previously-used MOAB mark for automotive wheels as to be likely to cause confusion, mistake, and/or to deceive consumers concerning an affiliation, connection, association, or sponsorship. Thus, the continued registration of Respondent's MOAB INDUSTRIES mark on the Principal Register is inconsistent with Petitioner's prior common law rights in the MOAB mark.

36. Chrysler has been and continues to be injured by the existence of U.S. Registration No. 3,912,705.

37. Registration No. 3,912,705 should therefore be cancelled pursuant to 15 U.S.C. § 1064(1).

WHEREFORE, Petitioner requests the Board to sustain this proceeding in Petitioner's favor and to cancel Registration No. 3,912,705. The Commissioner is authorized to debit Kilpatrick Townsend & Stockton LLP's deposit account No. 110860 if there is a deficiency in the required fee.

Dated: September 26, 2013

Respectfully submitted,

/s/Judith A. Powell

Judith A. Powell

Jennifer Fairbairn Deal

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Attorneys for Petitioner Chrysler Group LLC

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing PETITION TO CANCEL was served on Respondent's representative as identified in the correspondence address of record on September 26, 2013 via first class mail to:

John L. Silvernale dba Moab Industries
661 N. Bearclaw
Prescott ARIZONA 86301

/s/ Judith A. Powell
Judith A. Powell
Attorney for Petitioner

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing PETITION TO CANCEL is being filed electronically with the USPTO via ESTTA on this day, September 26, 2013.

/s/ Judith A. Powell
Judith A. Powell
Attorney for Petitioner